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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,250	02/27/2002	Geoffrey Stiff	52493.000251	2570

21967 7590 09/30/2010

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EXAMINER

SWARTZ, JAMIE H

ART UNIT	PAPER NUMBER
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3684

MAIL DATE	DELIVERY MODE
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09/30/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/083,250	Applicant(s) STIFF ET AL.	
	Examiner JAMIE H. SWARTZ	Art Unit 3684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-36 and 45-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-36 and 45-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status

1. Claims 30-36 and 45-59 are pending. Claims 30, 55, 58, and 59 have been amended. No claims have been cancelled, no claims have been added.

Response to Arguments

2. Applicant has cancelled the portions of the claims regarding details of an equity module determining the periodic retirement payment amount or determines whether it is greater than, equal to, or less than a guaranteed payment. Thus the 112 1st rejections regarding the details of an equity module determining the periodic retirement payment amount or determines whether it is greater than, equal to, or less than a guaranteed payment has been withdrawn.

3. Applicant's arguments filed June 15, 2010 have been fully considered but they are not persuasive.

4. The applicant states that the 112 2nd rejection on pages 5-6 of the applicant response has been overcome by amendment. The examiner respectfully disagrees. The amendment fails to clarify the 112 2nd rejection. There is no support in the specification for clarification of the claim. The examiner found support in Paragraph 96 regarding the periodic retirement income payment but merely states what happens when the periodic retirement income payment is greater than the guaranteed minimum periodic retirement

income payment amount. The cited portions fail to state anything about the periodic retirement income payment amount being less than the guaranteed minimum periodic retirement income payment amount. Further the applicant has not answered the questions that were posed to them in the 112 2nd rejection.

5. The applicant has argued on page 10 of applicant's arguments that Dellinger fails to teach manipulation of a "balance." The examiner respectfully disagrees. Dellinger teaches an adjustment module storing a balance in an adjustment account if the periodic retirement income payment amount is less than the guaranteed minimum periodic retirement income payment amount as can be seen in at least col. 8, lines 35-50 and col. 8, line 66 - col. 9, line 5. In Dellinger the "adjustment module" that stores the balance is the variable annuity benefit reserve. In the case that the payment falls below the minimum benefit payment money is taken out of the reserve. Thus the "adjustment module" balance goes down to meet the minimum balance payoff. In this specific case there is a negative balance stored in the benefit reserve account.

6. The applicant has argued on page 11 of applicant's arguments that because the variable annuity benefit is held by the insurer it is not associated with a user. The examiner respectfully disagrees. The applicant merely states that the balance is associated with a user and a minimum periodic retirement income payment amount. Therefore the insurer has the account but the balance is directly associated with the user. It is the user that is getting a minimum benefit payment amount and thus the

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balance is associated with whether or not the user's minimum benefit payment amount (guaranteed minimum periodic retirement income payment amount) is met. The actual balance amount requires knowing the user's minimum payment amount and calculating a difference. The applicant does not claim that the adjustment account is only associated with a user and not an insurer.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 30-36 and 45-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claims 30, 55, 58, and 59, the phrase "the adjustment module storing a balance in an adjustment account if the periodic retirement income payment amount is less than the guaranteed minimum period retirement income payment" renders the claim indefinite. It is unclear to the examiner how a balance would be stored in the adjustment account. If the periodic retirement income payment is less than the

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guaranteed minimum payment wouldn't the "balance" be a negative value? Thus there would be no balance to store into the adjustment account. For example if a minimum periodic retirement income payment amount is \$100, but the periodic retirement income payment amount is \$95, how is the value a positive \$5 left as the balance? Are the guaranteed minimum periodic retirement income payment amount an amount that is being put into a module, and then the periodic retirement income payment amount the value that is being paid out to the user? If the guaranteed periodic retirement income payment amount is the amount paid out to the user it would not make sense for there to be any funds left over if that value is greater then the periodic retirement income payment amount. Because the minimum payment amount is still a minimum payment amount and in order for it to be the minimum payment amount the user must be paid the minimum.

11. Regarding claims 30, 55, 58, and 59, the phrase "storing a balance, associated with the user and the guaranteed minimum periodic retirement income payment amount" renders the claim indefinite. It is unclear whether or not the balance is associated with a guaranteed minimum periodic retirement income payment or if the user is associated with the guaranteed minimum periodic retirement income payment.

12. Claim 30, 55, 58, and 59 recites the limitation "the guaranteed minimum periodic retirement income payment amount." There is insufficient antecedent basis for this limitation in the claim.

13. Claims 31-36, 45-54, and 56-57 are also rejected as being dependent on rejected claims.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 30-36 and 45-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dellinger et al. (US 7089201 B1) in view of Arena et al (US 20020184129 A1).

16. Regarding claim 30, Dellinger teaches a system for providing a user with a plurality of guaranteed minimum retirement income payments (see at least abstract, col. 4, lines 30-46, Fig 5). Dellinger teaches an equity module to receive an income generating payment and to output a periodic retirement income payment amount (see at least col. 4, line 30-46, Fig. 5, col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5). Dellinger teaches an adjustment module for comparing the periodic retirement income payment amount and the guaranteed minimum periodic retirement income payment amount, and for outputting to the user at least the guaranteed minimum periodic retirement income payment amount, with the adjustment module storing a balance, associated with the

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user and the guaranteed minimum periodic retirement income payment amount, in an adjustment account if the periodic retirement income payment amount is less than the guaranteed minimum periodic retirement income payment amount (see at least col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5). Dellinger does not specifically teach wherein the equity module determines that that payment amount. However, Arena teaches wherein a periodic retirement income payment amount is determined, by the equity module, to be greater than, equal to, or less than a guaranteed minimum periodic retirement income payment amount, such determination performed based on whether the income generating payments received are received according to a payment schedule (see at least ¶ 47). This known technique is applicable to the system of Dellinger as they both share characteristics and capabilities, namely they are both directed toward benefit payments based on an initial investment. One of ordinary skill in the art would have recognized that applying the known technique of Arena would have yielded a predictable result and resulted in an improved system. It would have been recognized that applying the technique of Arena to the teachings of Dellinger would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such benefit payment determinations into similar systems. Further, determining the payment value by the equity module would have been recognized by those of ordinary skill in the art as resulting in an improved system that would have allowed a guaranteed minimum payment as determined by the module.

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17. Regarding claim 31, Dellinger teaches wherein the equity module comprises at least one of a variable annuity module, a fixed annuity module, a mutual funds module, a variable life module, a single premium immediate annuity (SPIA) module, and an immediate variable annuity module (see at least col. 4, line 30 – col. 6, line 12).

18. Regarding claim 32, Dellinger teaches wherein the periodic retirement income payment may be calculated at one of the following annually, biennially, semi-annually, quarterly, monthly, bi-monthly, semi-monthly, weekly, and bi-weekly (see at least col. 7, lines 20-35, col. 12, line 60 – col. 13, line 5).

19. Regarding claim 33, Dellinger teaches wherein the guaranteed minimum periodic retirement income payment amount may be calculated at one of the following annually, biennially, semi-annually, quarterly, monthly, bi-monthly, semi-monthly, weekly, and bi-weekly (see at least col. 12, line 60 – col. 13, line 5).

20. Regarding claim 34, Dellinger teaches wherein the adjustment account balance is recovered by the performance of a unitized investment trust or an index (see at least col. 10, lines 3-15, col. 13, line 50 – col. 14, line 2).

21. Regarding claim 35, Dellinger teaches wherein the guaranteed minimum periodic retirement income payment amount is predetermined by the user (see at least col. 10, line 40-48, abstract).

22. Regarding claim 36, Dellinger teaches wherein the guaranteed minimum periodic retirement income payment amount is predetermined by the total premium payments made by the user during an accumulation period (see at least col. 18, lines 27-36).

23. Regarding claim 45, Dellinger teaches wherein the output of the adjustment module to the user is based on the balance in the adjustment account (see at least col. 5, lines 16-36, col. 11, lines 49-57).

24. Regarding claim 46, Dellinger teaches wherein the output of the adjustment module to the user is equal to the periodic retirement income payment amount, if the adjustment account balance is zero and the periodic retirement income payment amount is greater than the guaranteed minimum periodic retirement income payment amount (see at least col. 15, line 64 – col. 16, line 23, col. 8, lines 49-59, col. 11, lines 16-35).

25. Regarding claim 47, Dellinger teaches wherein the income generating payment comprises a plurality of predetermined scheduled premium payments (see at least col. 4, line 30 – col. 6, line 12, col. 13, lines 50 – col. 14, line 2).

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26. Regarding claim 48, Dellinger teaches wherein the income generating payment comprises a plurality of predetermined premium payments (see at least col. 4, line 30 – col. 61, line 12, col. 18, lines 13-60).

27. Regarding claim 49, Dellinger teaches wherein the income generating payment comprises a single premium payment (see at least col. 10, line 56 – col. 11, line 17).

28. Regarding claim 50, Dellinger teaches wherein the income generating payment comprises a plurality of premium payments (see at least col. 18, lines 15-67).

29. Regarding claim 51, Dellinger teaches wherein the guaranteed minimum periodic retirement income payment amount is determined by the amount and timing of the premium payments made by the user during the accumulation period (see at least col. 18, line 15-67, col. 4, line 30 – col. 6, line 12).

30. Regarding claim 52, Dellinger teaches wherein the adjustment account balance is forgiven as a death benefit during the annuitization period or at the expiration of the certain period, whichever occurs later (see at least abstract, col. 10, line 56 – col. 11, line 3, col. 11 lines 40 –49, col. 12, lines 10 –35, col. 14, lines 3 – 21).

31. Regarding claim 53, Dellinger teaches wherein an administrator retains a secured interest in future periodic retirement income payment amounts, if the

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adjustment account reflects a balance (see at least col. 4, line 55 – col. 5, line 16, col. 12, lines 43 –60, col. 14, lines 3-10, and lines 43 – 61).

32. Regarding claim 54, Dellinger teaches wherein the administrator is a financial services carrier (see at least abstract, claim 25).

33. Regarding claim 55, Dellinger teaches a method for providing a user with a plurality of guaranteed minimum retirement income payments, comprising: receiving an income generating payment at an equity module (see at least abstract, col. 4, lines 30-46, Fig 5) Dellinger teaches outputting a periodic retirement income payment amount, using the equity module, and wherein the guaranteed minimum periodic retirement income payment amount is defined by the user (see at least col. 4, line 30-46, Fig. 5, col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5, col. 18, lines 15-67). Dellinger teaches comparing the periodic retirement income payment amount and the guaranteed minimum periodic retirement income payment amount using an adjustment module (see at least col. 15, lines 35-63, col. 16, lines 37 – 57, col. 4, line 55 – col. 6, line 12). Dellinger teaches outputting, using the adjustment module, to the user at least the guaranteed minimum periodic retirement income payment amount, the adjustment module storing a balance, associated with the user and the guaranteed minimum periodic retirement income payment amount, in an adjustment account if the periodic retirement income payment amount is less than the guaranteed minimum periodic retirement income payment amount (see at least col. 4, line 30-46, Fig. 5, col. 8, lines

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35-50, col. 8, line 66 – col. 9, line 5, col. 18, lines 15-67, col. 5, lines 16-36, col. 11, lines 49 –57). Dellinger does not specifically teach wherein the equity module determines that that payment amount. However, Arena teaches using the equity module, wherein the periodic retirement income payment amount is determined to be greater than, equal to or less than a guaranteed minimum periodic retirement income payment amount, such determination performed based on whether the income generating payments received are received according to a predetermined payment schedule (see at least ¶ 47). This known technique is applicable to the system of Dellinger as they both share characteristics and capabilities, namely they are both directed toward benefit payments based on an initial investment. One of ordinary skill in the art would have recognized that applying the known technique of Arena would have yielded a predictable result and resulted in an improved system. It would have been recognized that applying the technique of Arena to the teachings of Dellinger would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such benefit payment determinations into similar systems. Further, determining the payment value by the equity module would have been recognized by those of ordinary skill in the art as resulting in an improved system that would have allowed a guaranteed minimum payment as determined by the module.

34. Regarding claim 56, Dellinger teaches forgiving the adjustment account balance as a death benefit during the annuitization period or at the expiration of the certain

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period, whichever occurs later (see at least abstract, col. 10, line 56 – col. 11, line 3, col. 11 lines 40 –49, col. 12, lines 10 –35, col. 14, lines 3 – 21).

35. Regarding claim 57, Dellinger teaches wherein the equity module comprises and equity indexed annuities or an equity indexed immediate annuities (see at least col. 10, lines 3-15, col. 13, line 50 – col. 14, line 2).

36. Regarding claim 58, Dellinger teaches a system for providing a user with a plurality of guaranteed minimum retirement income payments (see at least abstract, col. 4, lines 30-46, Fig 5). Dellinger teaches an equity module to receive an income generating payment and to output a periodic retirement income payment amount (see at least col. 4, line 30-46, Fig. 5, col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5). Dellinger teaches comparing the periodic retirement income payment amount and the guaranteed minimum periodic retirement income payment amount, determining if the periodic retirement income payment amount is greater than, equal to, or less than a guaranteed minimum periodic retirement income payment amount, and outputting to the user at least the guaranteed minimum periodic retirement income payment amount, with the adjustment module storing a balance, associated with the user and the guaranteed minimum periodic retirement income payment amount, in an adjustment account when the periodic retirement income payment amount is less than the guaranteed minimum periodic retirement income payment amount (see at least col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5). Dellinger does not specifically teach wherein the equity module

determines that that payment amount. However, Arena teaches wherein a periodic retirement income payment amount is determined, by the equity module, to be greater than, equal to, or less than a guaranteed minimum periodic retirement income payment amount, such determination performed based on whether the income generating payments received are received according to a payment schedule (see at least ¶ 47). This known technique is applicable to the system of Dellinger as they both share characteristics and capabilities, namely they are both directed toward benefit payments based on an initial investment. One of ordinary skill in the art would have recognized that applying the known technique of Arena would have yielded a predictable result and resulted in an improved system. It would have been recognized that applying the technique of Arena to the teachings of Dellinger would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such benefit payment determinations into similar systems. Further, determining the payment value by the equity module would have been recognized by those of ordinary skill in the art as resulting in an improved system that would have allowed a guaranteed minimum payment as determined by the module.

37. Regarding claim 59, Dellinger teaches a method for providing a user with a plurality of guaranteed minimum retirement income payments, comprising: receiving an income generating payment at an equity module (see at least abstract, col. 4, lines 30-46, Fig 5) Dellinger teaches outputting a periodic retirement income payment amount, using the equity module, and wherein the guaranteed minimum periodic retirement

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income payment amount is defined by the user (see at least col. 4, line 30-46, Fig. 5, col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5, col. 18, lines 15-67). Dellinger teaches comparing the periodic retirement income payment amount and the guaranteed minimum periodic retirement income payment amount using an adjustment module (see at least col. 15, lines 35-63, col. 16, lines 37 – 57, col. 4, line 55 – col. 6, line 12).

Dellinger teaches determining if the periodic retirement income payment amount is greater than, equal to, or less than a guaranteed minimum periodic retirement income payment amount outputting, using the adjustment module, to the user at least the guaranteed minimum periodic retirement income payment amount, the adjustment module storing a balance, associated with the user and the guaranteed minimum periodic retirement income payment amount, in an adjustment account when the periodic retirement income payment amount is less than the guaranteed minimum periodic retirement income payment amount (see at least col. 4, line 30-46, Fig. 5, col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5, col. 18, lines 15-67, col. 5, lines 16-36, col. 11, lines 49 –57). Dellinger does not specifically teach wherein the equity module determines that that payment amount. However, Arena teaches using the equity module, wherein the periodic retirement income payment amount is determined to be greater than, equal to or less than a guaranteed minimum periodic retirement income payment amount, such determination performed based on whether the income generating payments received are received according to a predetermined payment schedule (see at least ¶ 47). This known technique is applicable to the system of Dellinger as they both share characteristics and capabilities, namely they are both

directed toward benefit payments based on an initial investment. One of ordinary skill in the art would have recognized that applying the known technique of Arena would have yielded a predictable result and resulted in an improved system. It would have been recognized that applying the technique of Arena to the teachings of Dellinger would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such benefit payment determinations into similar systems. Further, determining the payment value by the equity module would have been recognized by those of ordinary skill in the art as resulting in an improved system that would have allowed a guaranteed minimum payment as determined by the module.

Conclusion

38. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMIE H. SWARTZ whose telephone number is (571)272-7363. The examiner can normally be reached on 8:00am-4:30pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571)272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. H. S./
Examiner, Art Unit 3684

/Kambiz Abdi/
Supervisory Patent Examiner,
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